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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#5

Applicant: Paul Martin Kenny, et la. Art Unit : Unknown  
U.S. Serial No.: 09/194,875 Examiner : Unknown  
Filed: December 4, 1998  
PCT No.: PCT/EP97/02888  
Int. Filing Date: 04 June 1997  
Priority Date: 04 June 1996  
Title : ELECTRONIC DEVICE WITH A SHIELDING ENCLOSURE

BOX PCT  
Assistant Commissioner of Patents  
Washington, D.C. 20231

ATTN: PCT Legal Office

**RECEIVED**

25 AUG 2000

Legal Staff  
International Division

RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)  
AND FOR TWO-MONTH EXTENSION OF TIME

Dear Sir:

This is in response to the Decision on Petition Under 37 C.F.R. § 1.47(a), mailed January 13, 2000.

The Decision noted that two items are required: (1) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, and (2) a statement of the last known address of the missing inventor. These items are provided as the attached Verified Statement of Facts Under 37 C.F.R. § 47 by Harry Hutchinson, and supporting documents.

Pursuant to 37 C.F.R. § 1.136, Applicants hereby petition that the period for response to the action dated January 13, 2000 be extended for two months to and including May 13, 2000. A check in the amount of \$380.00 for the extension fee is enclosed.

**RECEIVED**

JUL 15 2002

OFFICE OF PETITIONS

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service by first class mail with sufficient postage on the date indicated below and is addressed to the Assistant Commissioner of Patents, Washington, D.C. 20231.

Date of Deposit

René Curry

*May 15, 2000*  
*René Curry*

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380.00  
06/12/2000  
01 JUN 16

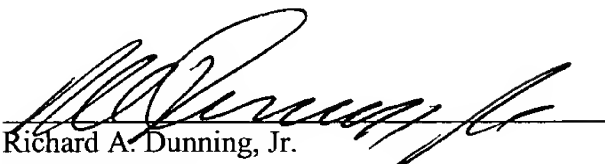
Applicant : Paul Martin Kenny, et al.  
Serial No. : 09/194,875  
Filed : December 4, 1998  
Page : 2

Attorney's Docket No.: 07217-012001

Respectfully submitted,

Date: \_\_\_\_\_

5/15/00

  
Richard A. Dunning, Jr.  
Reg. No. 42502

RAD/rzc

Enclosures

Fish & Richardson P.C.  
2200 Sand Hill Road, Suite 100  
Menlo Park, CA 94025  
Telephone: (650) 322-5070  
Facsimile: (650) 854-0875

50014474.doc

PATENT

ATTORNEY DOCKET NO. 07217/012001

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Martin Kenny, et al.  
Serial No.: 09/194,875  
Filing Date: 12/4/98  
Title : ELECTRONIC DEVICE

Art Unit: N/A  
Examiner: N/A

**VERIFIED STATEMENT OF FACTS UNDER 37 C.F.R. § 47 BY**  
**HARRY HUTCHINSON**

Commissioner for Patents  
and Trademarks  
Box DAC  
Washington, DC 20231

RECEIVED  
JUL 15 2002  
OFFICE OF PETITIONS

Dear Sir:

I, Harry Hutchinson of Derbyshire, United Kingdom, do hereby declare:

1. that I act in patent matters as a patent attorney retained by Pyronix Limited.
2. Mr John Konstandelos, of Doncaster, United Kingdom, and Mark Whitehead of Rotherham, United Kingdom, along with Mr. Paul Martin Kenny of X, Y, were indicated to me as being co-inventors of the invention recited in claims 1-10.
3. A patent application covering the subject matter of the instant invention was filed on June 4, 1996 in Great Britain. On June 4, 1997, a PCT application having International Application No. PCT/GB97/01513 was filed. This application claimed priority from the Great Britain application filed June 4, 1996. The PCT application eventually published as International Publication No. WO 97/47169.
4. On May 20, 1998, Mr. Paul Kenny left the employment of Pyronix Ltd. This is a company in which he and his former wife, Mrs. Julie A. Kenny were founder members. The issue of ownership and transfer of shareholdings is the subject of

protracted acrimonious legal proceedings.

5. On December 4, 1998, Pyronix Ltd. filed a U.S. national phase filing claiming priority to PCT application PCT/GB97/01513.

6. On April 18, 2000, I sent to Mr Paul Kenny a registered letter enclosing A Combined Declaration and Power of Attorney, a stamped and addressed envelope, a first covering letter for Mr Kenny to sign indicating that the Combined Declaration and Power of Attorney had been signed, a second covering letter for Mr Kenny to sign indicating that Mr Kenny refuses to sign document and that he has returned the unexecuted document, a copy of his contract of employment with Avecombe Electronics Limited, which later changed its name to Pyronix. A copy of all documents referred to above are submitted herewith. The registered letter requested Mr Kenny to sign and return the Combined Declaration and Power of Attorney, set out the UK law in relation to ownership of inventions made by Mr. Paul Kenny while working at Pyronix Limited and expressed the urgency with which the documents must be signed and returned. The registered letter contained a stamped, addressed envelope for the convenience of Mr Paul Kenny.

7. On May 4, 2000, I obtained from the United Kingdom Post Office proof of delivery of that registered letter to the address of Mr Paul Kenny. I noted that the letter had been delivered April 21, 2000. A copy of that proof is submitted herewith. It was noted that the registered letter was signed for by D Szubrycht.

8. On May 11, 2000, I attempted to telephone Mr Kenny in an attempt to determine whether or not he was willing to sign and return the documents or merely to return them unexecuted. Ms D Szubrycht, (Donna) answered the telephone and indicated that she was Mr Kenny's girlfriend and that she resides at 20 Larkspur Drive, East Kilbride, Glasgow, G74 4TD.

9. The undersigned hereby declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of United States Code and that

such wilful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Dated: 12 May 2020

Harry Hutchinson

Harry Hutchinson

Fountain Proinct  
Balm Green  
Sheffield S1 1RZ  
Direct Tel 0114 283 3264  
Direct Fax 0114 2730 312  
DX 708580 Sheffield 10

Your ref

Our ref HH.MC.P31659US

email: Harry.Hutchinson@dla-law.co.uk

20 April 2000

Mr P Kenny  
20 Larkspur Drive  
Stewartfield  
East Kilbride  
Scotland  
G74 4TD

Dear Paul

**US PATENT APPLICATION NO 09/194,875, US NATIONAL PHASE OF  
INTERNATIONAL PATENT APPLICATION NO PCT/GB97/01513  
APPLICANT - PYRONIX LIMITED**

As you know we have pending before the US Patent Office a number of US patent applications including the above US patent application. To progress the application to grant the US Patent Office prefers to have on file a signed "*Combined Declaration and Power of Attorney*" executed by the inventor.

You may be concerned that you are signing a document which procure for Pyronix rights to which you consider them not to be entitled. However, there are two aspects of the law which have a bearing on who owns the inventions for which you are an inventor.

Firstly, your contract of employment with Pyronix which provides that all inventions created by you during your period of employment by Pyronix are owned by Pyronix. You may recall that your contract of employment with Avecombe Electronics Limited, now known as Pyronix Limited following a change of name of 20<sup>th</sup> October 1986, provides in clause 12 for the ownership of inventions invented by you. Clause 12 reads "*any invention, discovery, design or item capable of having copyright, whether or not capable of protection by letters, patent, registered design or otherwise, made or discovered by the Managing Director which is connected with the business of the Company will belong absolutely to the Company. The Managing Director will provide the Company with full details and information with regard thereto and will, at the expense of the Company, apply or join with the Company, in applying for letters, patent, registration of the design or other protection in the United Kingdom or in any other part of the world therefor. The Managing Director will, at the Company's expense, execute and do all instruments and things which the Company may reasonably require to vest the absolute ownership in the said letters, patent, registered design or*

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UK office contact numbers: Calls from UK 08457 26 27 28 Calls from Overseas +44 114 272 0202

A list of partners' names is available for inspection at the above address

Website: [www.dla-law.co.uk](http://www.dla-law.co.uk)

Mr P Kenny  
Continuation 2  
20 April 2000

*other protection in the Company and in the meantime will hold all interests therein in trust for the Company". I have included a copy of that contract of employment for your convenience.*

Secondly, section 39 of the UK Patent Acts 1977 provides that all inventions made by an employee as a consequence of carrying out their normal duties or as a consequence of their position of employment being such as to carry a special obligation to further the interests of the company are owned by the employer. It is clear that an Managing Director of a company has a special obligation to further the interests of the company.

It can be appreciated from the above that, in either case, Pyronix are the legitimate owners of the invention that is the subject of the above US patent application.

We need to have the documents at the US Patent Office on or before **13 May 2000**. Hence, I have enclosed for your convenience a covering letter for the executed document. I should be grateful if you would either enclose the signed document with the covering letter. However, if you are inclined not to sign the documents, I have included an appropriate covering letter under which you can return the documents.

If you have any queries in relation to the above please do not hesitate to call me on 0114 283 3264.

Yours sincerely

**HARRY HUTCHINSON**  
European Patent Attorney



## PATENT

ATTORNEY DOCKET NO: 07217/01200  
COMBINED DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled ELECTRONIC DEVICE, the specification of which is attached hereto.

was filed on December 4, 1988 as Application Serial No. 09194.875

and was amended on \_\_\_\_\_

was described and claimed in PCT International Application No. PCT/GB97/01513 filed on 6/4/97 and was amended on \_\_\_\_\_

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose all information I know to be material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed.

COUNTRY	APPLICATION NO.	FILING DATE	PRIORITY CLAIMED
<u>PCT/GB</u>	<u>PCT/GB97/01513</u>	<u>6/4/97</u>	<u>Yes</u>

I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith: William J Egan, III, Reg No 28,411, David J Goren, Reg. No 34,609, Bao Q Tran, Reg No 37,955

Address all telephone calls to Bao Q Tran at telephone number 650/322-5070.

Address all correspondence to William J Egan III, Fish & Richardson P.C., 220 Sand Hill Road, Suite 100, Menlo Park, CA 94025

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

Full Name of Inventor: Paul Martin Kenny

Inventor's Signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence Address: East Kilbride, Scotland

Citizen of: United Kingdom

Post Office Address: 20 Larkspur Drive, Stewartfield, East Kilbride, Scotland, G74 4TD

AN AGREEMENT made the *Twenty Fifth* day of *July* 1986 BETWEEN  
AVECOMBE ELECTRONICS LIMITED whose Registered Office is situate at 44 Magna  
Crescent Wickersley Rotherham in the County of South Yorkshire S66 0HD  
(hereinafter called "the Company") of the one part and MR. PAUL MARTIN KENNY of  
44 Magna Crescent, Wickersley, Rotherham in the County of South Yorkshire  
(hereinafter called "the Managing Director") of the other part

WHEREBY IT IS AGREED as follows:

1.1 THE Company shall employ the Managing Director and the Managing Director shall serve the Company as Managing Director of the Company's business of Design; Manufacture and Sale of Passive Infra-Red technology based products (full details of the Company's business is detailed in the Memorandum of Association) or in such other capacity as the Board of Directors of the Company shall in their absolute discretion decide on and from 25th day of July 1986 until his employment shall be terminated as hereinafter provided

1.2 NO employment with a previous employer will count as part of the Managing Director period of continuous employment with the Company

2. THE remuneration of the Managing Director shall be:

2.1 A FIXED annual salary of £15,000 payable by twelve equal monthly instalments in arrear on the Sixteenth day of every month

2.2 THE annual salary shall be reviewed each year in the month following the financial year of the Company

3. THE Managing Director shall be required to work such reasonable hours as the Board of Directors of the Company may from time to time require and shall not be entitled to receive any additional remuneration for work outside his normal hours

4. THE Managing Director shall be required to work at such place or places within Great Britain as the Board of Directors of the Company may from time to time determine

5. THE Managing Director shall be entitled to five weeks holiday with pay in each calendar year in addition to all Statutory and Bank holidays at such time or times as may be agreed between himself and the Board of Directors of the Company and if the employment of the Managing Director terminates for any reason he shall

be entitled to an amount of accrued holiday pay in direct proportion to the length of his service during the calendar year in which the termination takes place. No holiday may be taken during a period of notice

6. THE holiday year of the Company shall be from the 1st January to the 31st December in any one year

7. DURING the continuance of this Agreement the Managing Director shall substantially devote his full time and efforts to the performance of his duties for the Company and shall do all in his power to promote, develop and extend the business and shall not directly or indirectly engage in any other business in competition with the said Company and will ensure that all patents, copyrights, trade marks, industrial designs and other intellectual property rights relating to the Company's products are vested absolutely in the Company

8. THE Managing Director shall not during the continuance of his employment hereunder or thereafter, except in the proper course of his duties as such Managing Director, divulge to any person whomsoever and shall use his best endeavours to prevent the unauthorised publication or disclosure of any trade secret or manufacturing process or any confidential information concerning the business or files of the Company or any of its dealings transactions or affairs which may come to his knowledge during or in the course of his employment

9. THE Managing Director shall use his best endeavours to ensure that the Company's products do not infringe any existing patents, trade marks, industrial designs, copyrights or other intellectual property rights

10. IF the Managing Director is absent from his duties as a result of sickness or injury he will be entitled to payment of his salary at the full rate less any other National Insurance sickness benefits receivable by him PROVIDED THAT:

10.1 IF the Managing Director is absent from his duties as a result of sickness or injury for a period of seven days or more he will produce to the Company appropriate medical certificates from a duly qualified medical practitioner in respect of such absence and payment of any sums payable to the Managing Director under this clause shall be conditional upon such medical certificates being produced

11. THE Managing Director will carry out such duties and comply with such instructions as the Board of Directors of the Company shall from time to time determine and subject to such aforesaid instruction shall exercise general control over and manage the business and all persons employed in or in connection with the same PROVIDED THAT:

11.1 THE Managing Director shall not engage or dismiss any persons employed in the business without the previous approval of the Board of Directors of the Company except in the case of serious misconduct or some emergency in which event the Managing Director shall immediately report such action and reason therefore to the Secretary of the Company

11.2 THE Managing Director shall not without the like approval make any arrangements by which the scale or rate of pay or the hours of work of any employees are varied nor without the consent of the Board of Directors of the Company enter into any arrangement by which any other term of any employee's contract of service shall be varied

12. ANY invention, discovery, design, or item capable of having copyright, whether or not capable of protection by letters, patent, registered design or otherwise, made or discovered by the Managing Director which is connected with the business of the Company will belong absolutely to the Company. The Managing Director will provide the Company with full details and information with regard thereto and will, at the expense of the Company, apply or join with the Company, in applying for letters, patent, registration of the design or other protection in the United Kingdom or in any other part of the world therefor. The Managing Director will, at the Company's expense, execute and do all instruments and things which the Company may reasonably require to vest the absolute ownership in the said letters, patent, registered design or other protection in the Company and in the meantime will hold all interests therein in trust for the Company.

13. The Managing Director shall not, for a period of one year from the termination of his employment directly or indirectly engage or be concerned in the identical business of the Company within 100 mile radius of the Registered Office or a factory unit of the Company.

14. THE Company will repay to the Managing Director all expenses incurred by him with its authority in connection with his employment

15. THE Company will within six months of the commencement of this agreement formulate plans for a pension scheme, details of which will be discussed at a Board Meeting at which the Managing Director will be present

15.1 THE Company will provide the Managing Director with medical insurance full details whereof will be available within three months of the commencement of this Agreement

16. THE Managing Director shall be provided with a motor car in accordance with the terms as decided by the Board of Directors in their absolute discretion

17. IN the event of the Managing Director having any grievance relating to the terms of his employment specified herein this grievance is to be discussed at a subsequent meeting of the Board of Directors

18. THE employment of the Managing Director may be determined at any time by the Managing Director giving to the Company, or the Company giving to the Managing Director six months' notice in writing of intention so to terminate

19. THE Company will be entitled to determine the employment of the Managing Director forthwith by Notice in writing if:

19.1 THE Managing Director is guilty of gross and/or persistent misconduct or gross dereliction of his duties

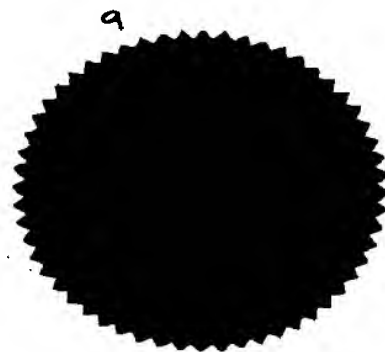
19.2 THE Managing Director has been absent from his duties for a period of 26 weeks (whether consecutive or in aggregate) in a period of one year as a result of sickness or injury.

20. THERE are no special disciplinary rules applicable to the Managing Director

21. NOTICES given under this Agreement should be in writing, and if to be given to the Company delivered or despatched by registered or recorded delivery post to its Registered Office and if to be given to the Managing Director handed to him or sent to him at his last known residential address in Great Britain by registered or recorded delivery post. A notice despatched by post in the aforementioned manner is deemed to be given three days after despatch

22. THE Managing Director will promote within the Company Health and Safety measures as a mutual objective for management and employees at all levels. The Managing Director will do all that is reasonable to prevent personal injury and damage to property and to protect everyone from foreseeable work hazards including the public insofar as they come into contact with the Company

THE COMMON SEAL OF AVECOMBE ELECTRONICS LIMITED  
was hereunto affixed in the presence of :



Director

Secretary

SIGNED by the said PAUL MARTIN KENNY  
in the presence of :

CS PATT  
420 RIMFORD ROAD  
SHEFFIELD S13 9ED  
Secy



**CERTIFICATE OF INCORPORATION  
ON CHANGE OF NAME**

No. 1996478

I hereby certify that

**AVECOMBE ELECTRONICS LIMITED**

having by special resolution changed its name, is now  
incorporated under the name of

**PYRONIX LIMITED**

Given under my hand at the Companies Registration Office,  
Cardiff the

20TH OCTOBER 1986

*E. Chadwick*  
MRS E. CHADWICK  
an authorised officer

20 Larkspur Drive  
Stewartfield  
East Kilbride  
Scotland  
G74 4TD

Harry Hutchinson  
Dibb Lupton Alsop  
Fountain Precinct  
Balm Green  
Sheffield  
S1 1RZ

Dear Harry

US Patent application Serial No. 09/194,875 - US National Phase of International Patent  
Application No. PCT/GB97/01513  
Applicant - Pyronix Limited

I refuse to execute the "*Combined Declaration and Power of Attorney*" enclosed with your letter of  
20 April 2000 and return the unexecuted documents herewith.

Yours sincerely

Paul Kenny



20 Larkspur Drive  
Stewartfield  
East Kilbride  
Scotland  
G74 4TD

Harry Hutchinson  
Dibb Lupton Alsop  
Fountain Precinct  
Balm Green  
Sheffield  
S1 1RZ

Dear Harry

**US Patent application Serial No. 09/194,875 - US National Phase of International Patent  
Application No. PCT/GB97/01513  
Applicant - Pyronix Limited**

Please find enclosed the "*Combined Declaration and Power of Attorney*" enclosed with your letter of 20 April 2000.

Yours sincerely

Paul Kenny

date 4 May 2000  
your ref  
our ref GLA10273431

ENTERED BY

5 MAY 2000

Mr H Hutchinson  
Dibb Lupton Alsop  
Fountain Precinct  
Balm Green  
SHEFFIELD  
S1 1RZ



Customer Service Centre  
The Guild Hall  
57 Queen Street  
GLASGOW  
G1 3AT

Telephone 08457 740 740

Dear Mr Hutchinson

Thank you for your enquiry of 27 April 2000 about a Special Delivery item number SW 7100 0357 4 GB, posted to Mr Kenny, 20 Larkspur Drive, East Kilbride, Glasgow, G74 4TD.

I can confirm that this item was delivered to that address on 21/4/00 and a photocopy of the signature we obtained is enclosed.

If we can be of any further assistance, please do not hesitate to contact us on 0141 242 4699.

Yours sincerely

Celia Hamilton  
Customer Service Advisor

Enclosures : Photocopy of Signature;



Affix the item barcode number and enter the time of delivery, or attempted delivery. The recipient must sign and print their name before the item is handed over.

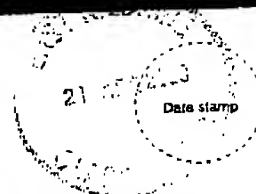
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31	NICK

SH 6793 4371 2GB 12.00pm sign



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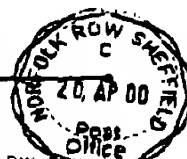
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We'll pay you compensation for the value of your item, up to the level paid for. For a claim form call 0345 740 740 calls charged at local rates, or pick one up at a post office

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Signature of postwoman

Signature of post office

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Signature of post office

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